

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventorship Rudolph
Applicant Microsoft Corp.
Group Art Unit 2157
Examiner El Chanti
Attorney's Docket No. ms1-641us
Title: "Methods and Systems for Processing Multi-media Editing projects"

APPEAL BRIEF

To: Commissioner for Patents
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Pursuant to 37 C.F.R. §41.37, Applicant hereby submits an appeal brief for application 09/732,086, filed December 6, 2000, within the requisite time from the date of filing the Notice of Appeal (August 1, 2006). Accordingly, Applicant appeals to the Board of Patent Appeals and Interferences seeking review of the Examiner's rejections.

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(1) Real Party in Interest

The real party in interest is Microsoft Corporation, the assignee of all right, title and interest in and to the subject invention.

(2) Related Appeals and Interferences

Appellant is not aware of any other appeals, interferences, or judicial proceedings which will directly affect, be directly affected by, or otherwise have a bearing on the Board's decision to this pending appeal.

(3) Status of Claims

Claims 1-11 stand rejected and are pending in the Application. Claims 1-11 are set forth in the Appendix of Appealed Claims on Page 12.

(4) Status of Amendments

The most recent Final Office Action was mailed June 30, 2006. No amendments were made thereafter.

(5) Summary of Claimed Subject Matter

A concise explanation of each of the independent claims is included in this Summary section, including specific reference characters, if any. These specific reference characters are examples of particular elements of the drawings for certain embodiments of the claimed subject matter and the claims are not limited to solely the elements corresponding to these reference characters.

With regard to claim 1, a method of processing a multi-media editing project (Page 9, lines 22-25) comprising: generating a request for one or more multi-media files for use in a multi-media editing project (Fig. 41 (4100), Page 53, lines 9-11), the request being generated by a user computer that comprises part of a network where multi-media files are maintained in a network – accessible location (Fig. 40 (4006, 4008, 4010), Page 52, lines 11-17); intercepting the request (Fig. 41 (4102), Page 53, lines 11-12); ascertaining whether a requested multi-media file is located on the user computer by checking one or more user-designated directories for the multi-media file (Fig. 41 (4104, 4106, 4108, 4110), Page 53, lines 12-24), wherein said one or more user-designated directories can be designated by a user specifying a path name for said one or more user-designated directories (Fig. 41 (4104, 4106, 4108, 4110), Page 53, lines 12-24); retrieving the multi-media file if the file is located on the user computer (Fig. 41 (4110, 4112, 4114, 4116), Page 53, line 25 through Page 54, line 5); and seeking the requested file from the network-accessible location if the multi-media file is not located on the user computer (Fig. 41 (4116, 4118), Page 54, lines 5-12).

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 1-11 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,421,733 to Tso et al. (hereinafter “Tso”).

(7) Argument

The rejections under 35 U.S.C. §103(a) over Tso fail because the Office has failed to establish a *prima facie* case of obviousness.

Applicant respectfully submits that the Office has not established a *prima facie* case of obviousness. The discussion below proceeds as follows. First, a section entitled “The § 103 Standard” is provided which describes the criteria that must be met in order to establish a *prima facie* case of obviousness. Second, a section entitled “The Claims” is provided which presents Applicant’s reasoning as to why the Office has not met these criteria.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, *there must be some suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-11

Claim 1 recites a method of processing a multi-media editing project comprising:

- generating a request for one or more multi-media files for use in a multi-media editing project, the request being generated by a user computer that comprises part of a network where multi-media files are maintained in a network –accessible location;
- intercepting the request;
- ascertaining whether a requested multi-media file is located on the user computer by checking one or more user-designated directories for the multi-media file, wherein said one or more user-designated directories can be designated by a user specifying a path name for said one or more user-designated directories;
- retrieving the multi-media file if the file is located on the user computer; and
- seeking the requested file from the network-accessible location if the multi-media file is not located on the user computer.

In making out the rejection of this claim, the Office argues that Tso discloses all of the claimed subject matter except for “designated by a user specifying a path name for said one or more user-designated directories”. The Office then argues it would have been obvious to modify Tso “by specifying the path name of the directories *because doing so would have the same functionality* which is to determine the existence of the requested files on the client computer before retrieving the file from a remote location.” (emphasis added).

Applicant respectfully disagrees and traverses the Office’s rejection. First, Applicant submits that the Office has mischaracterized the Tso reference. Specifically, the Office relies on Column 14 (lines 21-36) as disclosing “ascertaining ... by *checking one or more user-designated directories* for the

multi-media file”, as claimed. (emphasis added). This excerpt, however, simply fails to mention or even suggest “user-designated directories”. As such, it cannot possibly disclose designating such a directory “by a user specifying a path name”.

This excerpt, as well as the surrounding text, is reproduced below for the convenience of the Office. The specific excerpt cited by the Office is set off in bold italics.

In this particular embodiment, HTTP local proxy 48 first checks whether the requested hypertext object exists in client-side cache memory 56 (Step 120). To do this, HTTP local proxy 48 may invoke client-side parser 50 using a `GetScaledObject(URL)` call, which in turn issues a `GetEntry` call to client-side cache interface 54 to open a stream for the cached object. This effectively “retrieves” the cached object from client-side cache memory 56 if it exists (Step 140). HTTP local proxy 48 then passes the stream to browser 32, which displays the cached object to the user (Step 150).

Referring now to FIG. 8, if the requested URL object is not found in client-side cache memory 56, HTTP local proxy 48 transmits a request for the object to transcoding server 34 using, for example, a Post of a `GetStage(URL, Stage=0)` call (Step 160). Upon receipt of this call, HTTP remote proxy 36 invokes parser 22, which in turn issues a `GetScaledObject` a call to server-side cache interface 28 to determine whether a non-transcoded version of the requested hypertext object already exists in the server-side cache memory 30 (Step 170). If the hypertext object is cached, server-side cache interface 28 issues a `GetEntry` call to open a stream for the cached object (Step 200). In addition, parser 22 may issue a `GetProperties(URL, . . .)` call to server-side cache interface 28 to retrieve information about the transcoding properties and transcoded status (such as the refinement level) of the cached object.

If parser 22 determines that the requested hypertext object does not exist in the server-side cache memory 30, HTTP remote proxy 36 issues an HTTP request to retrieve the hypertext object from Internet 18 (Step 190). If the object is not found, HTTP remote proxy 36 returns an error to network client 12 which browser 32 will communicate to the user (Step 220); if the object is found, HTTP remote proxy 36 passes the handle for

the incoming data stream to parser 22, which in turn initiates caching of an original version of the retrieved hypertext object (Step 230).

Furthermore, even if Tso did disclose “ascertaining ... by checking one or more user-designated directories for the multi-media file”, which it does not, the Office’s stated motivation with respect to the proposed modification (“because doing so would have the same functionality”) is insufficient because it *fails to explain why one would be motivated* to make this particular modification. Specifically, it remains unclear why one would be motivated to modify Tso to provide functionality that, as the Office itself indicates, already exists. Any such motivation seems even more unlikely when considering that making the proposed modification would radically change the very principle of operation of Tso, which is based exclusively on checking cache memory on a client with a cache interface. (see, e.g. Tso, Column 13, lines 35-55 and Fig. 5).

With respect to the Office’s “Response to Arguments”, the Office states that in the previous non-final Office action, mailed February 11, 2005, it took Official Notice “that it would have been obvious for one of the ordinary skill in the art at the time of the invention to allow the user to specify a path name for one or more designated directories.” (See Office Action, page 5). The Office then proffers U.S. Patent No. 7,062,567 (Benitez et al.) as evidence that “it is well known in the art for a user to specify user designated directories.”

Applicant disagrees with the Office’s Official Notice for several reasons. First, Applicant has thoroughly reviewed the Office Action, mailed February 11, 2005, and is unable to find any such Official Notice therein. Second, Applicant submits that it is improper to take Official Notice of a non-factual assertion,

namely “that it would have been *obvious* for one of the ordinary skill in the art ...” (see, e.g. MPEP 2144.03). Third, Applicant submits that Benitez, first cited by the Office in the most recent final Office Action, fails to show that “it is well known in the art for a user to specify user designated directories” with respect to installing applications. For instance, Column 31 (lines 4-10) of Benitez simply indicates that frequently accessed files can be reordered to allow faster lookup of file information. Fourth, even if Benitez did contain evidence that “it is well known for a user to specify user designated directories” in the context of installing applications on a client, which it does not, this still could not be construed as showing that it is well know *in all contexts and situations*. Specifically, Tso is not directed to, or concerned with, installing applications. Instead, Tso is directed to a proxy server which is capable of examining data passing through it. (see Column 1, lines 64-65). Fifth, and perhaps most importantly, Applicant respectfully submits that by taking Official Notice and citing Benitez in the final Office Action, the Office is effectively introducing a new §103(a) reference and relying on new grounds for its rejection. As such, Applicant has not had an opportunity to respond to these new grounds during prosecution.

In summary, all of the claimed subject matter is not disclosed or suggested by Tso. Furthermore, the Office has failed to explain *why* one would have been motivated to modify Tso in the manner proposed by the Office. Therefore, Applicant can only conclude that the Office has impermissibly used the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Applicant respectfully reminds the Office that “[o]ne cannot use hindsight reconstruction to

pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting *In Re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Accordingly, in view of the above discussion, the Office has not established a *prima facie* case of obviousness. Hence, for at least these reasons, this claim is allowable.

Claims 2-11 depend from claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 1, are neither disclosed nor suggested by the reference of record.

In addition, regarding **claims 3 and 4**, Applicant submits that Column 14 (lines 21-36), reproduced above, simply fails to disclose or suggest “asking a user to designate a local directory if a requested file is not found on the user computer” or “searching for the requested file in a designated local directory”, as claimed. Accordingly, the Office’s reliance on this excerpt is misplaced.

In addition, regarding **claims 5-7**, Applicant submits that Column 14 (lines 21-36), reproduced above, simply fails to disclose or suggest “maintaining a list of directories”, as claimed or “checking directories on the list for the requested one or more files”. Instead, the HTTP local proxy simply begins cache memory whenever a user requests a hypertext document from the browser. Accordingly, the Office’s reliance on this excerpt is misplaced.

In addition, regarding **claims 8 and 9**, Applicant submits that Column 14 (lines 21-60) simply fails to disclose or suggest “maintaining a list of directories”, as claimed or “updating the list”, as claimed. Instead, the HTTP local proxy

simply begins cache memory whenever a user requests a hypertext document from the browser. Accordingly, the Office's reliance on this excerpt is misplaced.

In addition, regarding **claim 11**, Applicant submits that Tso simply does not discuss or even mention a "multi-media project editing application", as claimed. Accordingly, the Office's reliance on Tso is misplaced.

Conclusion

The Office has failed to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejections be overturned and that the pending claims be allowed to issue.

Dated: _____

8/30/2006

Respectfully Submitted,

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(8) Appendix of Appealed Claims

1. (Previously Presented) A method of processing a multi-media editing project comprising:

generating a request for one or more multi-media files for use in a multi-media editing project, the request being generated by a user computer that comprises part of a network where multi-media files are maintained in a network – accessible location;

intercepting the request;

ascertaining whether a requested multi-media file is located on the user computer by checking one or more user-designated directories for the multi-media file, wherein said one or more user-designated directories can be designated by a user specifying a path name for said one or more user-designated directories;

retrieving the multi-media file if the file is located on the user computer;
and

seeking the requested file from the network-accessible location if the multi-media file is not located on the user computer.

2. (Original) The method of claim 1 further comprising asking a user to designate a local directory if a requested file is not found on the user computer.

3. (Original) The method of claim 1 further comprising asking a user to designate a local directory if a requested file is not found on the user computer,

and then searching for the requested file in a designated local directory before seeking the requested file from the network-accessible location.

4. (Original) The method of claim 1, wherein said ascertaining comprises checking various predetermined file directories on the computer's hard drive.

5. (Original) The method of claim 1, wherein said ascertaining comprises:

maintaining a list of directories where multi-media files have been stored in the past; and

checking directories on the list for the requested one or more files.

6. (Original) The method of claim 1, wherein said ascertaining comprises:

maintaining a list of directories where multi-media files are stored; and

checking directories on the list for the requested one or more files.

7. (Original) The method of claim 1, wherein said ascertaining comprises:

maintaining a list of directories where multi-media files have been stored in the past or are presently stored; and

checking directories on the list for the requested one or more files.

8. (Original) The method of claim 1 further comprising:
maintaining a list of directories where multi-media files are stored; and
updating the list responsive to receiving and storing a multi-media file in a
local directory that is not on the list.
9. (Original) The method of claim 1 further comprising:
maintaining a list of directories where multi-media files are stored; and
updating the list responsive to a user designating a local directory that is not
on the list.
10. (Original) One or more computer-readable media having computer-
readable instructions thereon which, when executed by a computer, implement the
method of claim 1.
11. (Original) A multi-media project editing application configured for
execution on a user computer, the application being configured to implement the
method of claim 1.

(9) Evidence appendix. None

(10) Related proceedings appendix. None